

REMARKS

Reconsideration of this application is respectfully requested.

Claims 14-29 are new. New claims 14-30 are fully supported by the specification, for example at page 1, lines 11-13; page 12, line 29, through page 14, line 10; page 15, lines 18-24; page 16, lines 10-13; page 17, lines 3-11; and Figures 2, 3, 11, 12, 25, and 26. No new matter enters by amendment.

As requested by the Examiner, applicants submit herewith a copy of the original claims, which were involved in Interference No. 102,822.

Claim 13 was provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of copending Application No. 08/475,822 ("the '822 application").

Claim 17 has been canceled in the '822 application. Moreover, the obviousness-type double patenting rejection made by the Office was **PROVISIONAL**. The U.S. Court of Customs and Patent Appeals has explained the benefits of the provisional obviousness-type double patenting rejection practice. *In re Mott*, 190 U.S.P.Q. 536, 540 (1976). The applicant is made aware of the existence of "double-patenting" at an early date and has the opportunity, if he so desires, to elect which application to let issue. *Id.* Meanwhile, the PTO benefits by hastened prosecution. *Id.* In *Mott*, the PTO attempted, in effect, to make the rejection final rather than provisional. *Id.* The court did not permit this result. *Id.* In reaching its decision, the court indicated: "Once the provisional rejection has been made, there is nothing the examiner and the applicant must do until the other application issues." *Id.* at 541. Consequently, applicants need do nothing until applicants' other application issues.

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Claim 13 was rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Chang et al. (U.S. Patent No. 6,001,977). The Examiner alleges that Chang discloses the claimed nucleic acid.

Applicants traverse the rejection. The protein encoded by ORF-R is now known as the Nef protein of HIV-1. The sequences of Chang contain stop codons in the ORF-R (Nef) reading frame. The Office Action itself demonstrates this fact. That is, in the Office's alignment of one of Chang's sequences with applicants' claimed sequence, an in-frame "tag" stop codon appears between nucleotides 8512-8514 in the "Query" sequence of Chang, which is absent from applicants' "Subject" sequence (*i.e.*, "tgg" at this position coding for "W" at amino acid 134). As a result of these stop codons, the sequences of Chang do not encode a full-length HIV-1 Nef protein. Therefore, Chang cannot anticipate the claimed nucleic acids. Accordingly, applicants respectfully request withdrawal of the rejection.

Applicants respectfully submit that this application is now in condition for allowance. In the event that the Examiner disagrees, he is invited to call the undersigned to discuss any outstanding issues remaining in this application in order to expedite prosecution.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: November 18, 2002

By: \_\_\_\_\_

  
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